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| 10/535,492 | 05/17/2005 | Hyung-Nam Choi | 071308.0986 (2003P01541WO) | 3927 |
| 31625 | 7590 | 03/17/2009 | EXAMINER | |
| BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039 | | | KASRAIAN, ALLAHYAR | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/535,492 | Applicant(s) CHOI ET AL. | |
| | Examiner ALLAHYAR KASRAIAN | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 15-20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 15-20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The present Office Action is in response to Applicant's amendment filed on 12/12/2008. **Claims 13, 15-20 and 22-25** are now pending in the present application.

This Action is made FINAL.

Response to Arguments

2. Applicant's arguments filed 12/12/2008 have been fully considered but they are not persuasive.

On the second and third paragraphs of page 7 of the Applicants' arguments/remarks, Applicants argue, "the cited passage relates to the different transceivers a mobile device in *Knauerhase* can have. No information uniquely identifying a local area network is mentioned in *Knauerhase*. The Examiner is kindly requested to point out what he interprets to form such information." Examiner respectfully disagrees with Applicants, since the cited portion of *Knauerhase* discloses more than the different transceivers a mobile device. The multiple transceivers of the mobile device 300 uniquely and independently identify available local area networks such as Bluetooth, 802.11 or type of networks. In response to the Applicants' request regarding the cited portion, Examiner can point out to col. 3 lines 24-26 and lines 32-37 where *Knauerhase* clearly discloses, "the client selects 206 one of the transceivers and records 208 whether the selected transceiver has network connectivity... the client first selects 206 the Bluetooth transceiver 302 and records 208 whether the identified 200 location provides Bluetooth service. If 210 there are remaining untested transceivers,

e.g., the 802.11 and other transceivers 304, 306, they are also tested and their network connectivity recorded 208.”

On the fourth paragraph of page 7 of the Applicants’ arguments/remarks, Applicants argue, “The Examiner has indicated that *Knauerhase*, column 3, lines 19-26 and column 4, lines 1-57 discloses establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information... No information or data in these maps are for authorizing a dedicated connection. This is naturally so, because *Knauerhase* addresses distributing network information, and not authorization of network connections.” Examiner is persuaded that the cited portion does not clearly disclose the limitation. However, *Knauerhase* on FIG. 6, col. 4 lines 58-59 and col. 5 lines 10-33 discloses the claimed limitation: “FIG. 6 illustrates selecting connectivity based at least in part on obtaining a connectivity map from a map server... *the received connectivity map is consulted and evaluated* 610 to see which available of the available connectivity options identified by the connectivity map are most desirable. As different network connectivity may have different restrictions, costs, etc., for a particular current location of the client there may be less desirable network connectivity. After evaluating available network connectivity, *one is selected* 612... Also, if multiple connectivity is available, in one embodiment (not illustrated), if selected 612 connectivity is not available, the client may automatically fail-over and *select a less desirable but available connectivity*.”

Therefore, claims 13, 14, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by *Knauerhase*.

On page 8 of the Applicants' arguments/remarks, the third paragraph of section Rejections under 35 USC § 103(a), Applicants argues, "Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious." Examiner respectfully disagrees with Applicant since Knauerhase in view of Haverinen clearly disclose the limitations of claims 17-19 and 24-25 (see current and previous Office Actions).

On the second paragraph of page 9 of the Applicants' arguments/remarks, Applicants argue, "In *Haverinen*, a mobile station performs PLMN selection on the basis of a comparison of the received PLMN identifiers PLMN ID and the PLMN identifiers stored in the USIM. *Haverinen*, page 4, paragraph [0042], lines 1-4. In other words, both the received PLMN identifiers and stored PLMN identifiers are necessary for the network selection. Contrary hereto, the present invention permits a device to establish a connection to a local wireless network to receive a third party service only based on stored access information." Examiner respectfully disagrees with Applicant. One skilled in art should know when a mobile terminal reaches to a coverage area of an authorized wireless network, certain handshaking processes are supposed to be done for identifying the network and mobile station. It is impossible that a mobile station to operate within the area of a local area network (listed as identified network in the memory) without first identifying network and compare as if it is an authorized network, once the mobile station enters to the coverage area of the network. Examiner respectfully request the Applicant to describe (and point out on the specification) how it

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is possible for a device to establish a connection to a local wireless network to receive a third party service only based on stored access information *without identifying the network initially* (comparing the ID of the network with the ones stored on the USIM memory list).

Therefore, claims 17-19 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauerhase in view of Haverinen.

3. The references has been made herein are done so for the convenience of the applicant. They are in no way meant to limit the references. The reference **MUST** be considered in its entirety.

Claim Objections

4. **Claims 16, 18 and 23** are objected to because of the following informalities:

On **line 1** of **claim 16**, replace "14" with --13-- after "Claim";

On **line 1** of **claim 18**, replace "14" with --13-- after "Claim";

On **line 1** of **claim 23**, replace "21" with --20-- after "Claim";

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 13, 14, 20, and 21** are rejected under 35 U.S.C. 102(e) as being anticipated by **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase).

Consider **claims 13 and 20**, Knauerhase discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network, the second item of identification information comprising (FIGS.1, 3 for items of access information 302, 304 and 306 for how to connect to specific communication standard system, and FIG. 4 for connectivity for transceiver 208, col. 2 lines 10-16 and 44-53, col. 3 lines 27-48; the identification information are inherent with regards to connectivity to a certain item, e.g. the MS will be identified if it can connect to 802.11 or cellular network):

a first item of network information indicating the location of the local area network (col. 3 lines 27-43),

a second item of network information indicating the type of the local area network (FIG. 1 for region/sub-region 802.11 a and/or b, col. 2 lines 10-13 and 23-28 for types of

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network connectivity, col. 2 line 67-col. 3 line 9 for 802.11a or 802.11b types; FIG 3. for Bluetooth type or 802.11 family type), and

a third item of network information indicating at least one third party service provided by the local area network, wherein the third party service comprises access to one or more applications offered at the location (FIG. 1 for map server(s) 102, col. 2 lines 23-56, map server 102, an regional map servers provide the client global coverage map to inform the client of connectivity options; FIG. 5, col. 4 lines 1-57); and

a fourth item of network information uniquely identifying the local area network (col. 3 lines 27-48).

requesting a connection to the local wireless network via the terminal (col. 3, lines 21-43);

accessing the stored information (col. 6 lines 45-62); and

establishing a connection to a local wireless network to receive the third party service based on the stored access information (FIG. 6, col. 4 lines 58-59 and col. 5 lines 10-33).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 15-16 and 22-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase).

Consider **claims 15 and 22 as applied to claim 13 and 20 above respectively**, Knauerhase discloses the claimed invention except the first, second, and/or third items of network information are encoded by means of a maximum of three decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

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Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

Consider **claims 16 and 23 as applied to claim 14 and 21 above respectively**, Knauerhase discloses the claimed invention except the fourth item of network information is encoded by means of a maximum of five decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

9. **Claims 17-19 and 24-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Haverinen et al. (US Patent Application Pub. # 20030119481)** (hereinafter Haverinen).

Consider **claims 17 and 24 as applied to claim 13 and 20 above respectively**, Knauerhase discloses the claimed invention except the second items of identification

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information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of accessible network IDs as taught by Haverinen to the client device memory as disclosed by Knauerhase for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claims 18 and 25 as applied to claim 14 and 20 above respectively**, Knauerhase discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local

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area networks which forbid the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of forbidden network IDs as taught by Haverinen to the client device memory as disclosed by Knauerhase for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claim19 as applied to claim 13 above**, Knauerhase discloses the claimed invention except the at least first item of access information is stored on a device serving for user identification, in particular a USIM module.

In the same field of endeavor, Haverinen discloses the at least first item of access information is stored on a device serving for user identification, in particular a USIM module (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate a USIM module as disclosed by Haverinen to the client device as disclosed by Knauerhase for purpose of utilizing the network identifiers which are stored for allowing the client to connect to a specific network.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Allahyar Kasraian whose telephone number is (571) 270-1772. The Examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:00 p.m.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*/Allahyar Kasraian/
Examiner, Art Unit 2617*

A.K./ak

*/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617*

March 11, 2009